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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,996	01/26/2004	Christopher B. Bortnik	Schroeder-032209	6768
36787	7590	01/13/2006	EXAMINER	
BLYNN L. SHIDELER THE BLK LAW GROUP 3500 BROOKTREE ROAD SUITE 200 WEXFORD, PA 15090			CINTINS, IVARS C	
			ART UNIT	PAPER NUMBER
			1724	
DATE MAILED: 01/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/764,996	BORTNIK, CHRISTOPHER B.	
	Examiner	Art Unit	
	Ivars C. Cintins	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 14-25 is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

In view of the amendment filed October 24, 2005, the restriction requirement contained in the Office action dated May 18, 2005 is hereby withdrawn.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 8, 12 and 13 are again rejected under 35 U.S.C. 102(b) as being anticipated by Jewell et al. (U.S. Patent No. 4,828,698). The reference discloses a filter assembly comprising a filter element having a fluid permeable core **54** which may be made from metal (col. 5, line 45), a pleated filter media **52** disposed about the core, and an ion exchange resin layer **51** disposed about the pleated filter (col. 4, line 39); and this is all that is required by claims 1, 5, 6, 8, 12 and 13.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 and 9-11 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Jewell et al. in view of Haase (U.S. Patent No. 3,733,267). Jewell et al. discloses the claimed invention with the exception of the recited separation layers. Haase discloses a similar filter comprising a pleated filter media layer and a sorbent layer, and further teaches providing separation elements between these layers (see Fig. 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the filter assembly of

Jewell et al. with the separation elements of Haase, in order to provide separation between the ion exchange resin layer and pleated filter media layer of this primary reference device. Such modification is deemed to be especially obvious since Jewell et al. discloses that layers 50 and 51 can be entirely independent elements (see col. 4, line 59). Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct these separation elements from the materials recited in claims 4 and 11, since Jewell et al. discloses the use of glass or nylon for other components of the filter assembly (see col. 4, line 61).

Claim 7 is again rejected under 35 U.S.C. 103(a) as being unpatentable over Jewell et al. in view of Wong et al. (U.S. Patent No. 5,873,920). Jewell et al. discloses the claimed invention with the exception of the recited co-pleated filter media. Wong et al. discloses a filter media co-pleated with wire mesh (see col. 2, lines 46-47); and it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the filter media of Jewell et al. in a similar manner, in order to increase its structural stability.

Claims 14-25 are allowed because the references of record do not teach or fairly suggest a filter of the type recited having a housing connected to the lubricant fluid of a turbomachine.

Applicant's arguments filed October 24, 2005 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues that the present invention relates to a filter assembly adapted for use with turbomachinery for filtering fluid flow passing through such turbomachinery, whereas Jewell et al. is directed toward a water purification system useful where there is no electricity for pumps. It is pointed out, however, that since the filter element of Jewell et al. contains all of the recited filtration components (i.e. fluid permeable core 54, ion exchange resin 51, and pleated filter media 52 downstream of ion exchange resin

51), this reference filter is inherently capable of removing acids, water, particles and other material from a turbomachinery fluid; and this capability is all that is required by apparatus claims 1-13. Applicant should note that the intended use of a device (i.e. for filtering flow in turbomachinery) is not a structural limitation, and hence cannot be relied upon to patentably distinguish the above noted apparatus claims. It is well settled that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is 571-272-1155. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Duane Smith, can be reached at 571-272-1166.

The centralized facsimile number for the USPTO is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ivars Cintins
Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
January 9, 2006